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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/559,436

12/05/2005

Ryotaro Iwami

2005-1917A

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EXAMINER

NGUYEN, CUONG H

ART UNIT

PAPER NUMBER

3661

MAIL DATE

DELIVERY MODE

10/24/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/559,436

**Applicant(s)**

IWAMI ET AL.

**Examiner**

CUONG H. NGUYEN

**Art Unit**

3661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12/05/05 (the IDS).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 5-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,9 and 10 is/are rejected.
- 7) ☒ Claim(s) 2 and 5-8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                                   |                                                                                         |
|-----------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                              | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/05/05</u> . | 6) <input type="checkbox"/> Other: _____                                                |

***DETAILED ACTION***

1. This Office Action is the answer to an IDS received on 12/05/2005.
2. Claims 1-11 are pending in this application.

***Drawings***

3. 19 sheets of formal drawings are accepted by the examiner for examining purposes.

***Claim Rejections - 35 USC §101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

4. Independent claim 10 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

It is merely directed to a software per se (i.e., a computer program, see this claim's preamble); there is no medium involved (until dependent claim 11). It represents an abstract idea as it is not tangibly embodied and merely represents a data structure (e.g., "...step of designating ..", "...step of receiving ...", "...step of deriving ..." and "...step of selecting candidate location data ..." – nothing is claimed to execute those "steps").

This claim is absent to include a hardware/a storage medium to perform claimed functions (note that it does not assert that fact until a dependent claim 11); therefore, claim 10 is non-statutory for being directed to non-functional descriptive material per se.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1 and 9 are rejected under 35 U.S.C. 112, 2nd paragraph, as being unclear for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is a gap when the claimed menu option is NOT selected (in independent claim 1, applicant ONLY asserts a condition when that menu option is selected; therefore, the claim 1 is not complete as requirement in US format).

A. As per claim 1: There is insufficient information for "with a relatively detail method," the examiner is unclear about what is "a relatively detail method" that claimed (see claim 1, lines 18-19).

B. As per claim 1: "section" is used in many places; for example, "a data storage section" (see claim 1, line 2); according to this claim, physical components are directed to; therefore, for this meaning, "section" should be properly changed to "unit" or "component" (note that "section" is a very abstract term to be used for this particular meaning).

C. As per claim 1: "an output section" (see claim 1, line 24); according to this "apparatus" claim, physical components are directed to; therefore, for this meaning, "section" should be properly changed to "unit" or "component" ("section" is a very abstract term to be used for this meaning – is it a software section or a hardware unit/component? if it is a software section, what makes up that section? Is it still a physical component? – a concrete component is required).

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D. As per claim 1: "a determination section" is a very abstract term to be used for this meaning in a device of claim 1; is it a software section or a hardware unit/component? if it is a software section, what makes up that section?).

E. As per claim 1: The examiner fails to find out a concrete support for "the location-change designating section includes a priority assigning section".

F. As per claim 9: There is insufficient information for "with a relatively detail method," the examiner is unclear about what is "a relatively detail method" as claimed (see claim 9, lines 17-18).

G. As per claims 9- 10: There is insufficient information for "...at which a guiding method is to be changed" the examiner is unclear about this indefinite "guiding method" (see claim 9, lines 12-13, and claim 10).

6. Notes: About manner of claiming (i.e., as to claim 10):

According to MPEP,

I. The definition of the matter for which protection is sought shall be in terms of the technical features of the inventions.

II. Whenever appropriate, claims shall contain:

a. A statement indicating those technical features of the invention which are necessary for the definition of the claimed subject matter but which, in combination, are part of the prior art,

b. A characterizing portion – preceded by the words "characterized in that," "characterized by," "wherein the improvement comprises," or any other words to the same effect – stating concisely the technical features which, in combination with the features stated under (I), it is desired to protect.

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The claims must "define the matter for which protection is sought." Claims must be clear and concise. They must be fully supported by the description (claim 1, and 10 fail to conform to this rule). As to the manner of claiming, the claims must, whenever appropriate, be in two distinct parts; namely, the statement of the prior art and the statement of the features for which protection is sought ("the characterizing portion"). The physical requirements for the claims are the same as those for the description.

### ***Claim Rejections - 35 USC 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such **full, clear, concise, and exact terms** as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. There is no support for "a computer program" that claimed in claims 10-11; because these claims are directed to a computer program (see claim 10, line 1), comprises undisclosed software instructions/codes for performing steps (in claim 10); any person skilled in the art can not make and use the same and carrying out the inventor's invention without using the claimed program.

### ***Conclusion***

8. Claims 1, and 9-10 are rejected. Claims 2, 5-8 are objected.
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose telephone number is 571-272-6759. The examiner can normally be reached on 9:30 am - 5:30 pm.

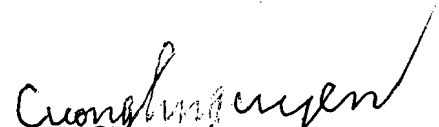
If attempts to reach the examiner by telephone are unsuccessful, the examiner's

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supervisor, THOMAS G. BLACK can be reached on 571-272-6956. The Rightfax number for the organization where this application is assigned is 571-273-6759.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Please provide support, with page and line numbers, for any amended or new claim in an effort to help advance prosecution; otherwise any new claim language that is introduced in an amended or new claim may be considered as new matter, especially if the Application is a Jumbo Application.

  
CUONG NGUYEN  
PRIMARY EXAMINER